

Remarks

Claims 1-25, 28-34, and 36-42 are pending in the application. Claims 26, 27, and 35 have been canceled without prejudice. Applicant reserves the right to file one or more continuing applications with claims drawing to the subject matter of these canceled claims. Claims 1, 13, 14, and 24 have been amended. The subject matter of claim of claim 4 has been incorporated into claim 24. The abstract has also been amended. Support for this amendment is found, for example, at claims 1-2. No new matter has been added to the application by virtue of these amendments.

I. Response to Objection to the Specification

The abstract was objected to for allegedly containing improper content. The abstract has been amended. It is respectfully submitted that this amendment obviates the objection. Thus, withdrawal of the objection is respectfully requested.

II. Response to Objection to the Drawings

The drawings were objected to under 37 C.F.R. § 1.83(a) for allegedly not showing every feature of the invention specified in the claims.

Claim 35, which recited a hydraulic lift, has been canceled so that a corrected drawing need not be prepared. Therefore, the

objection has been obviated, and withdrawal of the objection is respectfully requested.

III. Response to Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1-29 and 35 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In particular, the phrase "may be" was alleged to be indefinite in claims 1, 13, 14, 24, and 35.

A. Legal Standards under 35 U.S.C. § 112, Second Paragraph

The second paragraph of 35 U.S.C. § 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph, the second of which is that the claims must particularly point out and distinctly claim the invention.

The examiner's focus during examination of claims for compliance with the requirement for definiteness . . . is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. . . . [The examiner] should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. . . . The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.

Definiteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. 112, second paragraph is appropriate. *In re Wiggins*, 488 F.2d 538, 179 USPQ 421 (CCPA 1973).

MPEP § 2173.02 (emphasis in original); *In re Moore*, 169 U.S.P.Q. 236, 238 (C.C.P.A. 1971); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986); *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 225 U.S.P.Q. 634, 641 (Fed. Cir. 1985). Further, breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (C.C.P.A. 1971). For example, if a claim is too broad because it is not supported by the original description or an enabling disclosure, then a rejection under 35 U.S.C. § 112, first paragraph, is appropriate. Moreover, it has long been recognized that there is nothing inherently wrong with using functional language in drafting patent claims. The practical necessity of using functional language in certain circumstances has been recognized by the courts. *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226, 228 (C.C.P.A. 1971) (citing *In re Halleck*, 421 F.2d 911, 164 U.S.P.Q. 647 (C.C.P.A. 1970)). "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill

in the pertinent art in the context in which it is used." MPEP § 2173.05(g).

B. Response to Rejections of Claims 1, 13, 14, 24, and 35 under 35 U.S.C. § 112, Second Paragraph

Applicant respectfully submits that the phrase "may be" is not indefinite, because the claims set out and circumscribe the particular subject matter with a reasonable degree of clarity and particularity. When the claims are considered in light of the specification, the prior art, and the interpretation that would be given by a person of ordinary skill in the art, the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty.

A person of ordinary skill in the art would recognize that the recitation of "left and right booms may be interposed between said frame and rake arms" in claims 1 and 14 means that the left and right booms are interposable between the frame and rake arms. Therefore, these claims are not indefinite under Section 112, second paragraph. Notwithstanding, Applicant has amended claims 1 and 14 to substitute the equivalent language "are interposable" for the phrase "may be interposed" to advance the prosecution of this application and avoid further expense.

A person of ordinary skill in the art would also recognize that the recitation of "a locking plate may be used to secure the rake arm to the boom" in claim 13 means that a locking plate

selectively secures the rake arm to the boom. In other words, the locking plate can be used to secure the rake arm to the boom, or not. Therefore, this claim is not indefinite under Section 112, second paragraph. Nevertheless, Applicant has amended claims 13 to substitute the equivalent language "selectively secures" for the phrase "may be used to secure" to advance the prosecution of this application and avoid further expense.

A person of ordinary skill in the art would also recognize that the recitation of "said positioning means may be installed on said frame by said first coupling means and said rake arms may be installed on said positioning means by said second coupling means" in claim 24 means that the positioning means is installable on the frame by the first coupling means and the rake arms are installable on the positioning means by the second coupling means. Therefore, this claim is not indefinite under Section 112, second paragraph. Regardless, Applicant has amended claim 24 to substitute the equivalent language "is installable" or "are installable" for the phrase "may be installed" to advance the prosecution of this application and avoid further expense.

Claim 35 was canceled without prejudice so that amended drawings would not be needed. Therefore, the rejection of claim 35 under Section 112, second paragraph, is moot. However, a person of ordinary skill in the art would understand that recitation of "left and right hydraulic lifts may be used when raising and lowering the

left and right rake arms" means that the left and right hydraulic lifts are optionally used for raising and lowering the left and right rake arms. Therefore, claim 35 is not indefinite under Section 112, second paragraph.

For the reasons that (1) the recitations of "may be" in claims 1, 13, 14, 24, and 35 are not indefinite under § 112, second paragraph, and (2) claims 1, 13, 14, and 24 have been amended to recite equivalent language that obviates the rejections and claim 35 has been canceled to render the rejection moot, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested.

IV. Response to Rejections under 35 U.S.C. § 102

A. Standards for Examination under 35 U.S.C. § 102

Before discussing rejections based upon 35 U.S.C. § 102, it is believed proper to state that to sustain a rejection under § 102 the Patent and Trademark Office must abide by the following statement of the law.

Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

Akzo N.V. v. U.S. Int'l Trade Comm'n, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

B. Response to Rejection of Claims 1-3, 14-20, 30-32, and 36-42 under 35 U.S.C. § 102(b) as Being Anticipated by U.S. Patent No. 6,000,207

Claims 1-3, 14-20, 30-32, and 36-42 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,000,207 ("Menichetti").

Menichetti discloses a disassemblable hay rake of the "V" type. This rake includes (a) a tow bar, (b) a central frame detachably secured to the tow bar, (c) right and left lateral elements detachably and pivotally connected to the central frame, (d) right and left appendices adapted to receive right and left wheels, these appendices attached to the central frame and disposed between the right and left lateral elements, and (e) disassemblable right and left rake arm assemblies having a plurality of rake wheels detachably and rotatably secured thereto, the right and left rake arm assemblies detachably securable to the right and left lateral elements.

Independent claim 1 relates to a kit for reconfiguring a hay rake. A comparison of FIGS. 1 and 2 of the present application shows, at least in part, how this reconfiguration takes place. FIG. 1 shows that before reconfiguration the rake arms 108 and 110 are disposed on the frame such that the rotating tined wheels are disposed on the rake arms by their leading faces. FIG. 2 shows

that after reconfiguration the booms 130 and 132 are interposed between the frame and the rake arms, and the rotating tined wheels are disposed on the rake arms by their trailing faces.

Menichetti fails to disclose a conversion kit for reconfiguring a hay rake according to the presently claimed invention. More particularly, Menichetti fails to disclose booms that are interposable between the frame and the rake arms. The parts referred to in the Office Action as booms are not booms at all-they are rake arms according to the terminology used in the specification. Regardless, Menichetti fails to disclose how the so-called rake arms (as referred to in the Office Action) can be disposed on the frame and then how the rake can be reconfigured by interposing booms between the frame and the rake arms. Further, Menichetti fails to disclose that the booms are interposed between the frame and rake arms such that each of the plurality of rotating tined wheels is supported from its trailing face. Menichetti shows that the rotating tined wheels are supported by their leading faces (see, for example, FIG. 7 of Menichetti). Thus, one of the great advantages of the presently closed invention, namely that the rake arms do not get in the way of the hay as the hay is raked, is not achievable by the rake of Menichetti. Thus, Menichetti fails so disclose each and every element of the claimed invention.

Claims 2-3, which are dependent on claim 1, incorporate the limitations of claim 1. Therefore, Menichetti also fails to

disclose each and every element of the invention claimed in claims 2 and 3.

Independent claim 14 also relates to a conversion kit for reconfiguring a hay rake, the kit comprising left and right booms that are interposable between the frame and the rake arms such that when the booms are thus interposed the rotating tined wheels are supported by their trailing faces. As shown above, Menichetti fails to disclose booms that are interposable between the frame and the rake arms and also fails to disclose that when the booms are interposed between the frame and the rake arms that the rotating tined wheels are supported by their trailing faces. Therefore, Menichetti fails to disclose each and every element of claim 14.

Claims 15-20 are dependent on claim 14 and thus incorporate all of the limitations of claim 14. Therefore, Menichetti fails to disclose each and every element of claims 15-20.

Independent claim 30 is drawn to an apparatus comprising a frame, booms disposed on the frame at one end of the booms and disposed on rake arms at the other end of the booms, and rotating tined wheels disposed on the rake arms such that the rotating tined wheels are supported by their trailing faces. Menichetti fails to disclose a rake wherein the rotating tined wheels are supported by their trailing faces. Therefore, Menichetti fails to disclose each and every element of claim 30.

Claims 31 and 36 are dependent on claim 30. Hence, claims 31 and 36 incorporate all of the limitations of claim 30. Therefore, just as Menichetti fails to disclose each and every element of claim 30, Menichetti also fails to disclose each and every element of claims 31 and 36.

Independent claim 37 is drawn to a method of converting a hay rake, wherein the hay rake comprises a frame, a pair of rake arms disposed on the frame, and a plurality of rotating tined wheels disposed on the rake arms. The method comprises removing the rake arms from the frame, attaching a pair of booms to the frame in place of the rake arms, and then attaching the rake arms to the boom such that each of the plurality of rotating tined wheels is supported from its trailing face. Menichetti fails to disclose removing the rake arms from the frame, attaching a pair of booms to the frame in place of the rake arms, and then attaching the rake arms to the boom such that each of the plurality of rotating tined wheels is supported from its trailing face. Thus, Menichetti fails to disclose each and every element of claim 31.

Claims 38-42 are dependent on claim 37 and, thus, incorporate all of the limitations of claim 37. As with claim 37, Menichetti fails to disclose removing the rake arms from the frame, attaching booms to the frame in place of the rake arms, and attaching the rake arms to the booms such that the rotating tined wheels are

supported by their trailing faces. Therefore, Menichetti fails to disclose each and every limitation of claims 38-42.

Therefore, Menichetti fails to anticipate any of claims 1-3, 14-20, 30-32, and 36-42, because Menichetti fails to disclose each and every limitation of the presently claimed invention. Withdrawal of the rejection of these claims under 35 U.S.C. § 102(b) over Menichetti is thus respectfully requested.

C. Response to Rejection of Claims 24-29 under 35 U.S.C. § 102(b) as Being Anticipated by U.S. Patent No. 5,956,934

Claims 24-29 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,956,934 ("Wright").

Claim 24 has been amended to incorporate the subject matter of claim 4, which the Office Action admits is allowable subject matter in view of the prior art. Claims 26 and 27 have been canceled without prejudice.

In view of these amendments, it is respectfully submitted that claims 24, 25, 28, and 29 are not anticipated by Wright under 35 U.S.C. § 102(b). Withdrawal of the rejections is respectfully requested.

V. Allowable Subject Matter

The Office Action stated that claims 4-13, 21-23, and 35 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims.

The Office Action also stated that claims 33-34 were objected to as being dependent on a rejected base claims, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

Applicant respectfully thanks the Examiner for these determinations, but respectfully declines to rewrite these claims as suggested, because Applicant believes that all pending claims are allowable, as set forth above.

V. Conclusion

Should the Examiner deem it advisable to conduct a telephone interview for any reason, the undersigned attorney would be most agreeable to receiving a telephone call to expedite the prosecution of the application.

Appl. No. 10/693,324
Amendment dated July 27, 2004
Reply to Office Action of June 10, 2004

For the reasons given above, Applicant respectfully requests reconsideration and allowance of Claims 1-25, 28-34, and 36-42 and passage of this application to issue.

DATED this 27th day of July, 2004.

Respectfully submitted,



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